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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,595	03/17/2004	Takehiro Ikeda	250520US90	4182
22850	7590	12/21/2005		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER DAGOSTA, STEPHEN M	
			ART UNIT 2683	PAPER NUMBER

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,595

Applicant(s)

IKEDA ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☒ Claim(s) 4,5 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 3-20-2003. It is noted, however, that applicant has not filed a certified copy of the Japan-078915 application as required by 35 U.S.C. 119(b).

A Foreign Priority request was filed on 7-22-2004 but no priority papers were received by the US PTO – please transmit the papers again.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should **avoid using phrases** which can be implied, such as, "The disclosure concerns," "The disclosure defined by this **invention**," "The disclosure describes," etc.

- The word "invention" should be deleted

Information Disclosure Statement

The information disclosure statement filed 9-22-2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein (FOR DOCUMENTS **EP-1021055** and **DE-10064955**) has not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 6 and 7: A narrow/broad range or limitation together with a broad/narrow range or limitation that falls within the narrow/broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, **claims 1, 6 and 7** recite the narrow recitation "greatest accuracy", and the claim also recites "invers said location" which is the broader statement of the range/limitation. In the examiner's opinion, it would be better to state that the location is "transmitted" and not inferred.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6 rejected under 35 U.S.C. 102(b) as being anticipated by Whinnet et al. GB-2313257.

As per **claim 1**, Whinnet teaches a mobile unit that is capable of communication using a plurality of communication subsystems (abstract and figure 1 show mobile unit communicating with multiple wireless networks), characterized in that it comprises:

determination means that determines usability (eg. availability) of the plurality of communication subsystems at the current location of said mobile unit (figure 2, #33 teaches receiving an indication of available communication systems);

selection means that selects a communication subsystem whereby the current location can be measured with the greatest accuracy, of the communication subsystems that are determined as usable by said determination means (page 6, L28 to C7, L27 teaches using either active or passive location determination); and

transmission means that infers/transmits said current location using the communication subsystem selected by said selection means and transmits the result of determination of said usability by said determination means, together with information indicating said current location, using the communication subsystem selected by said selection means (page 6, L8-18 teaches sending information from mobile to server/bulletin board).

With further regard to claim 6, Whinnet teaches

a reception step for receiving the determination result of said usability transmitted in said transmission step, together with information indicating said current location (page 6, L8-18);

a storage step of storing in storage means in updateable fashion as geographical information the result of determination of said usability received in said reception step,

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in correspondence with information indicating said current location (page 6, L8-17 teaches the bulletin board receiving information from the mobile and extracting irrelevant data, hence the system must inherently store the received mobile data in order to keep itself updated with where the mobile is/was).

a communication subsystem specification step of specifying a communication subsystem that can be used at said current location or at a location designated by said mobile unit, by looking up the geographical information stored in said storage means; and a notification step of notifying said mobile unit of a usable communication subsystem specified in said communication subsystem specification step, in response to a request from the mobile unit (C6, L15-18)..

As per **claim 2**, Whinnet teaches claim 1 and a server (eg. bulletin board) characterized in that it comprises:

communication means that receives the result of determination of said usability transmitted by the transmission means of the mobile unit according to claim 1, together with information indicating said current location; (page 6, L8-18); and

storage means that stores in updateable fashion the result of determination of said usability received by said communication means as geographical information, in correspondence with information indicating said current location (page 6, L8-17 teaches the bulletin board receiving information from the mobile and extracting irrelevant data, hence the system must inherently store the received mobile data in order to keep itself updated with where the mobile is/was).

As per **claim 3**, Davenport teaches claim 2 characterized in that, it further comprises communication subsystem specification means that specifies a communication subsystem that is usable at said current location or at a location designated by said mobile unit, by looking up the geographical information stored in said storage means; and, said communication means notifies said mobile unit of the usable communication system specified by said communication system specification means, in response to a request from the mobile unit (C6, L15-18).

Allowable Subject Matter

1. **Claims 4-5** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 4: The prior art of record, either alone or in combination, does not recite: region specification means that specifies a geographical region to which the current location belongs, based on information indicating said current location received by said communication means; and storage means that stores in updateable fashion as frequency-of-use information the number of times per unit time that a usability determination result has been received by said communication means, in correspondence with the usable communication subsystem indicated by determination result and geographical region specified by said region specification means.

Claim 5: Depends from claim 4 and is therefore allowable as well.

2. **Claim 7 allowed.** The prior art of record, either alone or in combination, does not recite:

a region specification step of specifying a geographical region to which the current location belongs, based on the information indicating said current location received in said reception step; a storage step of storing in storage means in updateable fashion as frequency-of-use information the number of times per unit time that the result of determination of usability has been received in said reception step, in correspondence with the usable communication subsystem indicated by said determination result and the geographical region specified in said region specification step; a frequency specification step of specifying the frequency-of-use of the each communication subsystem in the geographical region to which said current location or the location designated by said mobile unit belongs, by looking up the frequency-of-use information stored in said storage means; and a notification step of notifying said mobile unit of the frequency-of-use specified in said frequency specification step, in response to a request from the mobile unit.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Meadows et al. US 6,716,101
2. Wieczorek et al. US 6,125,278
3. Ladner et al. US 6,331,825
4. Pu et al. US 6,292,743
5. George 5,214,789

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
Primary Examiner

